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09/401,873	09/23/1999	Stuart Serkin	09857/029001	5264
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FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER BUCHANAN, CHRISTOPHER R	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

09/401,873

## Applicant(s)

SERKIN ET AL.

## Examiner

CHRISTOPHER R. BUCHANAN

## Art Unit

3627

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, 7-12 and 14-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7-12 and 14-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4, 5, 7-12, and 14-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Korhammer (US 6,278,982), the NASD reference, and the Smith et al. reference.

*Independent claim 1*

NASD discloses a common interface to provide a single, common point of entry for coupling order delivery systems and quote entry systems that send quotes to the collector facility; a manager process that manages quotes received from the quote entry systems and orders received from the order delivery systems; and an order routing/execution manager to provide for all orders received by the common interface either a single point delivery of executions or routing of orders in accordance with parameters of the order (FF 14& 15). Korhammer shows an exemplary system that would incorporate NASD's terminals in NASD's proposed environment (FF 04-08). Since the functionality previously contained in the two separate SOES and SelectNet systems will be integrated into a single system, there must be some parameter

associated with orders to direct processing along the appropriate functionality stream. This solves the double liability problem argued by the Appellants (Br. 9-10: Last ¶- Top of page) (FF 20).

Furthermore, the NASD reference discloses the order execution manager receiving a request to cancel an order from a market participant (p. 11 par. 1, recipient permitted to decline an order, i.e., cancel an order). The particular reason for canceling the order would be a matter of design choice. Also, it is well-known to place orders that are "good until cancelled", which suggests that the system provides some means for participants to cancel orders.

*Dependent claims 4, 5, and 7-12*

Claim 4 - Managing multiple quotes and orders at multiple price levels is shown by the management of the limit order file in NASD, since a limit order file contains multiple quotes and orders at multiple price levels (FF 18).

Claim 5 - Aggregate or current quote montage is shown by the three methods of display in NASD, including montage and full displays (FF 18). Korhammer shows a full display (FF 10). Display is consistent with parameters in the quotes such as the security and price.

Claims 7-12 recite implementation details of the NASD operations as taught by Smith, prior to the date of the invention, and their applicability to these claims is not

contended by the Appellants. Such implementation details show the operations inherent in Korhammer's system as applied toward NASD transactions.

*Independent claim 14*

Claim 14's collector facility for an electronic market having "[ 1] an interface for coupling order delivery systems to the collector facility; [2] a quote manager that manages quotes/orders received from the interface at multiple price levels; and [3] a montage manager to [3(a)] display quotes received from the quote order manager in [3(a)(i)] an aggregate montage and [3(a)(ii)] an attributable quote montage [3(b)] if the quotes are attributable consistent with parameters specified in the quotes" is shown by Korhammer and NASD as outlined for claim 1, *supra*, regarding the interface, and as outlined for claim 5, *supra*, regarding the aggregate and full montage display. The newly added limitation regards display of attributable orders.

We initially find that element [3(b)] is ambiguous in its effect on the scope of the claim, particularly element [3(a)(ii)]. This structural element [3(a)(ii)] recites the capacity to perform a display step. The performance of [3(a)(ii)] is contingent upon whether [3(b)] is true.

If the condition for performing a contingent step in a method claim is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed. Similarly, in an apparatus claim that recites structure to perform steps, absent an element that tests for the contingent condition, if the condition

for performing a contingent step claim would not be satisfied in operation, the structure that performs the recited step need not be present in order for the claimed structure to be met.

Therefore, it is ambiguous as to whether elements [3(a)(ii)] and [3(b)] limit the scope of the claim. Accordingly, we analyze the patentability of claim 14 under both constructions of limiting and not so limiting.

If elements [3(a)(ii)] and [3(b)] do not limit the scope of the claim, then claim 14 is simply a subset of the subject matter of claims 1 and 5, whose limitations we found, *supra*. If they do limit the scope, then, in addition, we find the following.

We find that Korhammer displays an attributable montage (FF 10) whereas NASD proposes to display anonymous, i.e. non-attributable, montages (FF 19). Thus, one of ordinary skill would have seen examples of both attributed and non-attributed quotes in the art at the time of the invention and would have envisaged combining the display of both aggregate and attributable full montages, based on the disclosed practice of each alternative. Essentially, the aggregate montage is a summary version of the full montage and combined displays of summary and detail levels of data are notoriously old in all areas of finance and accounting. Thus, it would have been obvious to a person of ordinary skill in the art to have combined the displays to provide detail and summary reporting.

Parameters associated with an order are provided as a matter of normal operation and would therefore have been the most readily apparent vehicle for signaling

the selection whether to show quotes as attributable. Thus, it would have been obvious to a person of ordinary skill in the art to have displayed quotes in an aggregate montage and an attributable quote montage if the quotes are attributable consistent with parameters specified in the quotes.

Furthermore, the NASD reference discloses the order execution manager receiving a request to cancel an order from a market participant (p. 11 par. 1, recipient permitted to decline an order, i.e., cancel an order). The particular reason for canceling the order would be a matter of design choice. Also, it is well-known to place orders that are "good until cancelled", which suggests that the system provides some means for participants to cancel orders.

#### *Dependent Claims 15-19 and 25*

Dependent claims 15-19 and 25 combine the subject matter of claim 14 with various combinations of claims 4, 5, and 7-12 and the analysis for their rejection follows that of those claims accordingly.

#### *Independent Claims 20 and 21*

Claims 20 and 21 are for a method and a program product that each contains substantially similar limitations to the other. Their subject matter of [1 ] interfacing a plurality of disparate order delivery systems to an order collector facility that provides a

central point of access to the disparate order delivery systems; [2] receiving multiple quotes/orders received from the interface at multiple price levels; [3] displaying in an aggregate montage indicators of an aggregate of the quotes received; and [4] displaying those of the received quotes that represent attributable interest in a quote montage consistent with attribution parameters specified in the multiple quotes is shown by Korhammer and NASD as outlined for claim 1, *supra*, regarding the interface; and as outlined for claim 5, *supra*, regarding the aggregate and full montage display; and as outlined for claim 4, *supra*, regarding multiple quotes and orders and multiple price levels; and as outlined for claim 14, *supra*, regarding display of attributable quotes. The analysis of the rejection for claims 20 and 21 follows that of those claims accordingly.

Furthermore, the NASD reference discloses the order execution manager receiving a request to cancel an order from a market participant (p. 11 par. 1, recipient permitted to decline an order, i.e., cancel an order). The particular reason for canceling the order would be a matter of design choice. Also, it is well-known to place orders that are "good until cancelled", which suggests that the system provides some means for participants to cancel orders.

#### *Dependent Claims 22-24 and 26-33*

Dependent claims 22, 24, 26, 28 and 29 combine the subject matter of claim 20 with claims 4, 7 and 8 and the analysis for their rejection follows that of those claims accordingly. Claims 23 and 27 recites the operation of routing orders according to their



nature, as generally taught by Korhammer (FF 08). Regarding claims 30-33, the order manager must either accept or decline the request and the particular criteria required for each option would be a matter of design choice.

### ***Response to Arguments***

3. Applicant's arguments filed October 5, 2007 have been fully considered but they are not persuasive. Applicant argues that the prior art do not disclose the claimed feature of receiving by the order manager a request to cancel an order from a market participant.

The examiner disagrees and stands by the rejection. As pointed out in the rejection above, the NASD reference discloses the request to cancel feature.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER R. BUCHANAN whose telephone number is (571)272-8134. The examiner can normally be reached on Mon.-Fri. 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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